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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,850	03/23/2001	Roger de la Torre	514362000100	6920

7590 05/03/2004

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EXAMINER


ODLAND, KATHRYN P

ART UNIT PAPER NUMBER

3743

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/816,850	Applicant(s) TORRE ET AL.	
	Examiner Kathryn Odland	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-45 is/are pending in the application.
- 4a) Of the above claim(s) 4-8, 11-27 and 31-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,9 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This is a response to the amendment dated March 15, 2004. Claims 1, 3, 9, and 28-30 are under consideration. Claims 4-8, 11-27 and 31-45 are withdrawn from consideration. The amendments to the drawings and specification are acknowledged.

### **Response to Arguments**

1. Applicant's arguments with respect to the rejection(s) of claim(s) 28-30 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Saadat in US 2003/0093117.
2. Applicant's arguments with respect to claims 1-3 and 9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, and 9 are rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Petrick in US Patent No. 6,060,639.

Regarding claims 1 and 9, Petrick discloses a space-occupying device (10) having an inflatable member (12) with an inflation valve (18) and one or more fasteners (sutures via tab 22) secured to the expandable member and capable of anchoring the device, where the fasteners are configured such that they **can** extend at least partially through a stomach wall but not external to a patient's body, as recited throughout the specification. The limitation, "the inflatable member adapted for disposition entirely within the patient's stomach," is not given patentable weight. The apparatus of Petrick is capable of being implanted in a stomach and applicant is reminded that functional language does not hold patentable weight in apparatus claims.

Regarding claim 3, Petrick discloses that as applied to claim 1, as well as fasteners that are sutures, as recited in column 4.

5. Claims 1, 3, 9, and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Saadat in US 2003/0093117.

Regarding claim 1 and 9, Saadat discloses a space-occupying device (such as 172 and associated components, etc.) for deployment within a patient's stomach having an inflatable member (such as 172) with an inflation valve (such as 184), where the inflatable member is adapted to be disposed entirely within the patient's stomach; and one or more fasteners (such as 176) secured to the expandable member capable of anchoring the device within the stomach where the one or more fasteners are configured such that portion can extend at least

partially through the patient's stomach wall but not external to the patient's body, as recited on pages 7-10.

Regarding claim 3, Saadat discloses that as applied to claim 1, as well as, fasteners that are sutures, as recited in section [0119], for example.

Regarding claims 28 and 29, Saadat discloses a method of anchoring a space-occupying device within the stomach of a patient as well as fasteners that are sutures, as recited above with respect to claims 1, 3, and 9.

6. Claim 30 is rejected under 35 U.S.C. 102(e)/103(a) as being anticipated by Saadat in US 2003/0093117.

Regarding claim 30, Saadat discloses that as applied to claim 28. Further, suturing the device prior to inflation is within the scope of the invention and would be obvious to one with ordinary skill in the art.

### ***Conclusion***

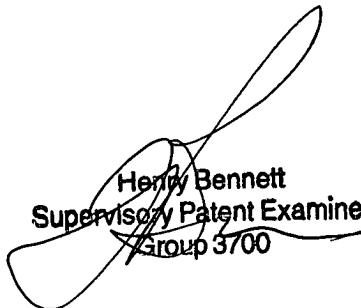
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO



Henry Bennett  
Supervisory Patent Examiner  
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